

Appl. No. 10/758,657  
Amdt. dated 09/27/2006  
Reply to Office action of 06/27/2006

### REMARKS

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#### I. IN THE OFFICE ACTION

Claims 1-20 are pending and stand rejected.

Claims 1, 2, 4, 6-8, 10, 12-15 and 17 stand rejected as obvious over Petersen (5,679,258) in view of Rudder (5,173,092).

Claims 3, 9, 18 and 19 stand rejected as obvious over Petersen in view of Rudder and further in view of Fritz (5,979,012)

Claims 5, 11, 16 and 20 stand rejected as obvious over Petersen in view of Rudder and further in view of Cantrell et al. (4,139,332).

#### II. DISCUSSION OF REJECTIONS

##### A. Standard of Anticipation

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Moreover, it is not enough that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Id*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added).

##### B. Standard of Obviousness

Before a claim may be rejected under section 103, the examiner must establish a *prima facie* case of obviousness. See MPEP, Section 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or combine the reference teachings. Second, there must be a

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reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP, Section 2143.

Identification in the prior art of each individual part claimed in a patent is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicant. *In re Kotzab*, 217 F.3d at 1370. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *Id.* The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *Id.* In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *Id.* Whether an express or implicit showing is relied upon, particular findings related thereto must be provided. *Id.* Broad conclusory statements standing alone are not "evidence." *Id.*

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, the applicant is under no obligation to submit evidence of nonobviousness." MPEP, Section 2142.

### C. Argument

Applicant respectfully cancels claims 1-20 and adds new claims 21-34 to clarify the invention. New base claims 21 and 26 clarify that an internal combustion engine provides the vacuum in the first tank and the recovery well via a conduit (Specification, paragraphs 18 through 20). The cited documents do not teach or suggest an internal combustion engine providing a vacuum.

In regard to original claims 5, 11 and 16 the examiner asserts that "Cantrell teaches such engines (column 1, lines 17-36 and column 4, lines 28-44, etc)." (Office Action, page 5). Column 1, lines 17-36 of Cantrell et al. merely points out that internal combustion engines are commonly used to drive pumps in relation to transferring fluids between tanks. At column 4, lines 28-44, Cantrell et al. teaches controlling the speed of an internal engine and the connected

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pump relative to a fluid level in a tank. Cantrell et al. does not teach or suggest using an internal combustion engine to provide a vacuum on a tank or on a recovery well.

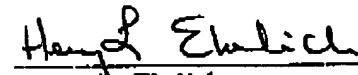
Applicant respectfully submits that the cited documents, singularly and in combination, fail to anticipate applicant's claims. Thus, Applicant respectfully requests that the rejections be withdrawn and that a Notice of Allowance be mailed.

The Examiner is invited to contact Applicant's below named representative to move this application forward.

Respectfully submitted,  
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DATE

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